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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,353	08/14/2001	Naoya Suzuki	212667US6	6434
22850	7590	11/10/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			WALSH, JOHN B	
			ART UNIT	PAPER NUMBER

2151

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,353

Applicant(s)

SUZUKI, NAOYA

Examiner

John B. Walsh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/14/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites "said information processing device scroll-displays". It is unclear how the information processing device can perform the function of scroll-displaying since no structure has been set forth in the claim or previous claims to support displaying. The remote control terminal has been recited as comprising display means, yet the information processing device does not.

Claim 6 recites the limitation "said display means". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1, 2 and 8-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,216,158 to Luo et al.

Luo et al. disclose an information processing system comprising a remote controller terminal (palm sized computer, 100) and an information processing device (110, 120, 130, 140, 150; column 1, lines 18-19), said information processing system wherein: said remote controller terminal comprises: function item information receiving means (inherent that palm has a receiver for receiving information from the information processing device, i.e. an antenna; see column 5, lines 57-65 connectivity) for receiving function item information corresponding to each function had by said information processing device which is operated from said information processing device by radio (column 5, lines 57-65); and transmitting means (inherent that palm has a transmitter for transmitting information to communicate with the information processing device, i.e. an antenna; see column 5, lines 57-65 connectivity) for transmitting a processing command corresponding processing command the function item information to said information processing device by radio accordance with user's input operation, and said information processing device comprises: processing command receiving means (inherent that information processing device has a receiver for receiving information from the remote terminal in order to communicate) for receiving the processing command transmitted from said remote controller terminal; and control means (inherent that information processing device has a CPU for controlling, column 1, lines 18-19) for controlling the function corresponding to the processing command to execute processing corresponding to the user's input operation to said remote controller terminal.

As concerns claim 2, wherein said remote controller terminal further comprises: display means (figure 1, palm 100 has a screen for displaying) displaying a plurality function item names

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corresponding plurality of function item information received by said function item information receiving means by radio (column 5, lines 57-65); and operation means (input capabilities; column 1, lines 24-25) for selecting and determining a desired function item name out of the plurality of function item names accordance with the input operation.

As concerns claim 8, an information processing device (110, 120, 130, 140, 150, column 1, lines 18-19) comprising: function item information transmitting means (inherent that information processing device has a transmitter for transmitting information to the remote terminal in order to communicate) transmitting function item information corresponding to own functions to a remote controller terminal by radio; processing command receiving means (inherent that information processing device has a receiver for receiving information from the remote terminal in order to communicate) for receiving a processing command corresponding to the function item information transmitted from said remote controller terminal by radio (column 5, lines 57-65); and control means (inherent that information processing device has a CPU for controlling, column 1, lines 18-19) for controlling the function corresponding the processing command to execute predetermined processing in accordance with instructions from said remote controller terminal.

As concerns claim 9, display means (figure 1; monitor screen for displaying) for scroll-displaying the plurality of function item names in accordance with rotation operation of said operation means by a user and remarkably displaying a desired function item name being selected, on the basis of the processing command received by said processing command receiving means by radio from said remote controller terminal.

As concerns claim 10, wherein said display means scroll-displays the plurality of

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function item names and remarkably displays a desired function item name being selected, associated with the display contents of display means said remote controller terminal (column 4, lines 12-13; palm remotely operates the information processing device such that what occurs on the screen of the palm occurs on a screen of the information processing device).

As concerns claim 11, an information processing method comprising: a function item information transmitting step (inherent that information processing device has a transmitter for transmitting information to the remote terminal in order to communicate) of transmitting function item information corresponding to own functions a remote controller terminal by radio (column 5, lines 57-65); a processing command receiving step (inherent that information processing device has a receiver for receiving information from the remote terminal in order to communicate) receiving a processing command corresponding the function item information transmitted from said remote controller terminal; and a control step (inherent that information processing device has a CPU for controlling, column 1, lines 18-19) of controlling the function corresponding to the processing command to execute predetermined processing in accordance with instructions from said remote controller terminal.

As concerns claim 12, a program to be executed by an information processing device, comprising a function item information transmitting step (inherent that information processing device has a transmitter for transmitting information to the remote terminal in order to communicate) of transmitting function item information corresponding to own functions remote controller terminal by radio (column 5, lines 57-65); a processing command receiving step () of receiving a processing command corresponding to the function item information transmitted from said remote controller terminal; and a control step (inherent that information processing device has a CPU for controlling, column 1, lines 18-19) of controlling the function

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corresponding the processing command execute predetermined processing accordance with instructions from the remote controller terminal.

As concerns claim 13, a remote controller terminal comprising: function item information receiving means (inherent that palm has a receiver for receiving information from the information processing device, i.e. an antenna; see column 5, lines 57-65 connectivity) for receiving function item information corresponding to functions had by an information processing device to be operated, from said information processing device radio (column 5, lines 57-65); and processing command transmitting means (inherent that palm has a transmitter for transmitting information to communicate with the information processing device, i.e. an antenna; see column 5, lines 57-65 connectivity) for transmitting a processing command corresponding to the function item information to the information processing device by radio accordance with user's input operation.

As concerns claim 14, wherein display means (figure 1, display screen of 100) for displaying a plurality of function item names corresponding to a plurality function item information received by said function item information received by said item information receiving means; operation means (inherent that palm has a CPU for controlling) for selecting and determining a desired function item name out of the plurality of function item names in accordance with the input operation.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-6, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,216,158 to Luo et al. as applied to claims 2 and 14 above in view of U.S. Patent No. 6,662,244 to Takahashi.

As concerns claims 3 and 15, wherein said operation means is a jog dial for selecting a desired function item name out of the plurality of function item names by rotation operation and fixing the selection of item name by pushing operation.

Luo et al. '158 do not explicitly disclose a jog dial.

Takahashi '244 teaches a jog dial (10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the palm of Luo et al. '158 with a jog dial, as taught by Takahashi '244, in order to provide a means of selecting a desired function with one hand which also is used to hold the palm as well.

As concerns claims 4 and 16, wherein said display means of said remote controller terminal scroll-displays the plurality of function item names in accordance with the rotation operation of said operation means by the user, and also remarkably displays a desired function item name being selected (inherent that a jog dial will scroll through a display of functions when rotated).

As concerns claim 5, wherein said information processing device scroll-displays the plurality of function item names according to rotation operation of said operation means by the user and also remarkably displays a desired function item name being selected: on the basis of

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the processing command received by said processing command receiving means from said remote controller terminal (column 4, lines 12-13, palm remotely operates the information processing device such that what occurs on the screen of the palm occurs on a screen of the information processing device).

As concerns claim 6, wherein said display means of said information processing device scroll-displays the plurality of function item names and remarkably displays a desired function item name being selected, associated with the display means of said remote controller terminal (column 4, lines 12-13, palm remotely operates the information processing device such that what occurs on the screen of the palm occurs on a screen of the information processing device).

7. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,216,158 to Luo et al.

As concerns claims 7 and 17, wherein said remote controller terminal is a portable telephone comprising the display means of the remote controller terminal for displaying a plurality of function item names corresponding to the plurality of function item information received by said function item information receiving means and operation means (input capabilities, column 1, lines 24-25) for selecting and determining a desired function item name out of the plurality of function item names in accordance with the input operation.

The limitation of the remote controller terminal is a portable telephone, is seen as an obvious design choice. The applicant's specification on page 26 indicates that a PDA can be used as another kind of remote control. Therefore the applicant's admission that another kind of device may be used as a remote control is indication that remote control terminal need not be a portable telephone as long as the remote control terminal performs the claimed functions, i.e. display means, which in the instant case is satisfied by the palm pilot (i.e. PDA) of Luo et al.

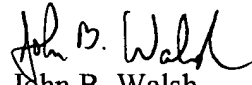
Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Friday from 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John B. Walsh
Primary Examiner
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